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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,432	06/07/2001	David T. Berquist	56777USA3A.002	8956

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EXAMINER	
KOYAMA, KUMIKO C	

ART UNIT	PAPER NUMBER
2876	

DATE MAILED: 06/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/876,432	Applicant(s) BERQUIST ET AL.
	Examiner Kumiko C. Koyama	Art Unit 2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-49 and 67-74* is/are pending in the application.

4a) Of the above claim(s) *50-66* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-49 and 67-74* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☒ The proposed drawing correction filed on *21 February 2003* is: a)☒ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *5&6* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I in Paper No. 8 received on February 21, 2003 is acknowledged. The traversal is on the ground(s) that a separate examination of the claims in Group I, II and III would require substantial duplication of work on the part of the U.S. Patent and Trademark Office and entails serious burden on the Applicant's assignee. This is not found persuasive because each group requires separate searches and interpretations for examination. Therefore, the examiner maintains her position as set forth in Paper No. 7. The requirement is still deemed proper and is therefore made FINAL.

Drawings

2. The proposed drawing correction and/or the proposed substitute sheets of drawings, as well as amendments to the specification accommodating these drawings, filed on February 21, 2003 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

Double Patenting

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claim 18 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 60 of copending Application No. 09/882,969. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-24, 48-49 and 67-74 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 60 and 64-77 of copending Application No. 09/882,969 (herein after '969 application). Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention is a broader recitation of the '969 application.

Re claim 1 of the present invention: Claim 1 of the present invention recites "A method of collecting information related to RFID tags associated with items of interest, comprising the steps of: (a) selecting a category of items using a user interface associated with an RFID reader;

(b) using the RFID reader to interrogate at least one RFID tag associated with an item of interest; and (c) associating information related to the at least one item with the selected cateogy."

Re claim 60 of '969 application: Claim 60 of the '969 invention recites "A method of interrogating RFID tags associated with items of interest, comprising the steps of: (a) selecting at least one category of items using a user interface associated with an RFID reader; (b) interrogating RFID tags associated with items, at least one of which is within the category of items; (c) categorizing information related to the at least one item(s) associated with the interrogated RFID tag(s) in at least one of the categories; and (d) ignoring any RFID-tagged-item that may not be categorized in at least one category."

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 32-37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-16 and 42 of copending Application No. 09/755,714 (herein after '714 application). Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention is a broader recitation of the '714 application.

Re claim 32 of the present invention: Claim 32 of the present invention recites "A method of obtaining information related to items associated with RFID tags, comprising the steps of: (a) interrogating the RFID tags in an order; and (b) organizing the information in an order other than the order in which the tags were interrogated."

Re claim 37 of '714 application: Claim 37 of '714 application recites "A method of using an RFID reader for interrogating RFID tags associated with items of interest, by programming

the RFID reader to provide specified information regarding each item of interest in a specified order on a user interface associated with the RFID reader, at least some of the information being selected from the group consisting of a name or title of the item, s serial or call number of the item, and a desired location for the item."

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. Claims 1-7, 25-38, 40, 41 and 48-49 are rejected under 35 U.S.C. 102(a) as being anticipated by Garber et al (US 6,232,870).

Garber teaches a method of using a portable RFID device with a group of items each having an RFID tag, inputting information to the device describing a certain item or class of items, scanning the RFID tags associated with each item in the group of items, receiving signals from each of the scanned RFID tags, and comparing the received signals to the information input to the device to determine whether the certain item or class of items are present amount the group of items (col 18, lines 55+).

Re claim 2: Garber further teaches recording in a database that the item or items of interest were located (col 19, lines 15-16).

Re claim 25 and 38: Garber teaches using the information input to update a database that includes information to an item (col 20, lines 11-12), scanning the RFID element associated with the item and determining whether the certain item belongs with the group of items (col 19, lines 45-51).

Re claim 32 and 48: Garber teaches inputting an algorithm to the device that describes an ordered set of items, scanning a plurality of items having RFID elements to obtain information from those elements, which serves as interrogating the RFID tags in an order, and comparing a description of the items obtained using the information obtained from the RFID elements to the algorithm to determine whether the scanned items or in the algorithm order, which serves as organizing the information in an order other than the order in which the tags were interrogated (col 19, lines 19-27). Garber also teaches providing an indication to a user of any item that is not in the algorithm order (col 19, lines 27-30).

Re claim 40 and 41: Garber teaches interrogating RFID tags, each associated with an item to determine information related to the items for a first purpose of searching for certain items on a predetermine search list and using the information for a second purpose of determining the presence or absence of the items in the storage area (col 18, lines 55+ and col 19, line 1-5).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claim 8-17 and 67-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garber et al and Wishneusky et al (US 4,975,828).

Garber teaches a method of using a portable RFID device with a group of items each having an RFID tag, inputting information to the device describing a certain item or class of items, scanning the RFID tags associated with each item in the group of items, receiving signals from each of the scanned RFID tags, and comparing the received signals to the information input to the device to determine whether the certain item or class of items are present amount the group of items (col 18, lines 55+).

Garber fails to teach selecting at least two categories of items and categorizing information related to the at least one item associated with the interrogated RFID tag in at least one of the categories.

Wishneusky teaches categorizing each received data character into one of the selected plurality of categories (col 107, lines 41-52).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Wishneusky to the teachings of Garber in order to organize information and items so that when the user searches or retrieves certain item with certain characteristics, the processor can easily obtain the category as well as the items in a fast manner.

12. Claim 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garber, Wishneusky and Harrison et al (US 6,176,425).

Garber teaches a method of using a portable RFID device with a group of items each having an RFID tag, inputting information to the device describing a certain item or class of items, scanning the RFID tags associated with each item in the group of items, receiving signals from each of the scanned RFID tags, and comparing the received signals to the information input to the device to determine whether the certain item or class of items are present amount the group of items (col 18, lines 55+).

Garber fails to teach selecting at least two categories of items and categorizing information related to the at least one item associated with the interrogated RFID tag in at least one of the categories.

Wishneusky teaches categorizing each received data character into one of the selected plurality of categories (col 107, lines 41-52).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Wishneusky to the teachings of Garber in order to organize information and items so that when the user searches or retrieves certain item with certain characteristics, the processor can easily obtain the category as well as the items in a fast manner.

Garber as modified by Wishneusky fail to teach ignoring any RFID-tagged item that may not be categorized in at least one category.

Harrison teaches that if a tag identification number is detected which is not associated with any semantics, the program can ignore the tag (col 13, lines 40-48).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Harrison to the teachings of Garber as

modified by Wishneusky so that other unrelated tags are not associated with the certain category, and avoid any confusion to the user as well as to the program used in the interrogating equipment to properly perform the function.

13. Claims 39, 42-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garber in view of Boley et al (US 6,411,211).

Garber teaches interrogating RFID tags, each associated with an item, to obtain information for a first purpose of determining whether the items are in a predetermined order within a storage area/library (col 19, lines 18-31).

Garber fails to teach that using information obtained for a second purpose of determining the presence or absence of the items in the storage area.

Boley teaches an RF transponder and an interrogations systems for determining the presence or absence of golf clubs (col 7, lines 15-28, lines 49-50).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Boley to the teachings of Garber and determine the presence or absence of the items in order to prevent missing, stolen, and lost items, and quickly determine the items availability.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Mabry et al., U.S. Patent No. 6,330,971, discloses a radio refrequency identification system and method for tracking silicon wafers.

Bowers et al., U.S. Patent No. 6,195,006, discloses an inventory system using articles with RFID tags.

Reynolds et al., U.S. Patent No. 6,318,636, discloses method and apparatus to read different types of data carriers, such RFID tags and machine-readable symbols, and a user interface for the same.

Issacman et al., U.S. Patent No. 6,127,928, discloses method and apparatus for locating and tracking documents and other objects.

Mon, U.S. Patent No. 6,354,493, discloses system and method for finding a specific RFID tagged article located in a plurality of RFID tagged articles.

Radican, U.S. Patent No. 6,148,291, discloses a container and inventory monitoring methods and systems.

Werb et al., U.S. Patent No. 6,456,239, discloses a method and apparatus for locating mobile tags.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kumiko C. Koyama whose telephone number is 703-305-5425. The examiner can normally be reached on Monday-Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Kumiko C. Koyama
Kumiko C. Koyama
June 13, 2003

MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
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